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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,215	06/09/2005	Warner Rudolph Theophile Ten Kate	NL 021375	1789

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EXAMINER	
TSUI, WILSON W	

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/538,215	TEN KATE ET AL.	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the RCE filed on: 01/28/08.

2. Claims 1-10 are cancelled. Claims 11-30 are new.

3. The following claims are withdrawn, due to new grounds of rejection, necessitated by applicant's amendment:

- Claims 1, 2, 3, 5, 6, 8, and 10 rejected under 35 U.S.C. 102(b) as being anticipated by Himmel et al
- Claims 4, 7, and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al, in further view of Metz et al

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. With regards to claim 21, the claimed "player" appears to be a "computer program per se". Since the computer program is not embodied on a computer readable medium, it is not statutory. See MPEP 2106 below:

> Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held non statutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In

> contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus statutory

6. With regards to claims 22-27, for depending upon claim 21, are rejected under similar rationale.

7. With regards to claim 28, the claimed information carrier is a form of electromagnetic energy, and does not fall into one of the statutory categories of 35 U.S.C. 101, the claim includes non-statutory subject matter. A detailed explanation describing why carrier waves are regarded as non-statutory subject matter under 35 U.S.C. 101 follows:

> Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.
>
> First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.
>
> "The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." Shell Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), aff'd, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See American Disappearing Bed Co. v. Arnaelsteen, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. Lorillard v. Pons, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in American Fruit Growers when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

8. With regards to claims 29 and 30; since they depend on independent claim 28;

they are rejected under similar rationale.

Priority

9. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.

10/538215, filed on 06/09/2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 11- 19, 21, and 23-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Freund (US Patent: 5,987,611, issued: Nov. 16, 1999, filed: May 6, 1997).

With regards to claim 11, Freund teaches a method comprising:

Receiving content information and application information related to the content information from an information carrier (Abstract: whereas, a client based monitoring and filtering system receives the type of application, and application access information related to the content information)*;*

Determining a sub-collection of documents based on the application information (Abstract: whereas a sub-collection of documents is determined through a list of URLs, based on application data)*,*

Facilitating internet access to documents within the sub-collection, and encumbering Internet access to documents that are not within the sub-collection (Abstract: whereas, internet access is granted to the document-reader/client or blocked based upon whether or not documents are within the sub-collection).

With regards to claim 12, which depends on claim 11, Fruend teaches wherein the application information includes an identification of the documents in the sub-collection (Abstract: whereas, the documents are identified through URLs)

With regards to claim 13, which depends on claim 11, Freund teaches wherein the application information includes an identification of a location for determining the sub-collection (Abstract: whereas URLs, supply the location for determining a document in a subcollection..

With regards to claim 14, which depends on claim 13, Freund teaches wherein the location includes one of the information carrier, another information carrier, an internet site, and a broadcast station (Abstract: whereas the location includes an internet site, specified through a URL).

With regards to claim 15, which depends on claim 13, Freund teaches wherein the location is configured to provide an interactive presentation that constrains Internet access to only the documents that are within the sub-collection (Abstract: whereas, the location is used to provide document presentation within the sub-collection)

With regards to claim 16, which depends on claim 13, Freund teaches wherein the location is configured to provide reference to the sub-collection (Abstract: whereas, the location provides reference to a document within a sub-collection).

With regards to claim 17, which depends on claim 11, Freund teaches wherein at least one document in the sub collection is identified by one of a uniform resource identifier and a uniform resource locator (Abstract: whereas, a document within the sub-collection is identified through a uniform resource locator).

With regards to claim 18, which depends on claim 11, Freund teaches including executing code of the application information to facilitate internet access to the documents within the sub-collection (Abstract: whereas a process/application is checked and executed upon granted access to documents within the subcollection).

With regards to claim 19, which depends on claim 11, wherein the information carrier includes one of a portable medium and a broadcast medium (column 7, lines 35-45: whereas, a portable medium includes a removable floppy disk).

With regards to claim 21, for a player performing a method similar to the method of claim 11, is rejected under similar rationale.

With regards to claim 23, which depends on claim 21, Freund teaches *wherein the access device is configured to provide Internet access only when the information carrier is operatively coupled to the reader* (column 7, lines 60-67: whereas the software system in the access device only runs when using/retrieving data from a information carrier/storage medium).

With regards to claim 24, which depends on claim 21, for a player that performs a method similar to the method of claim 12, is rejected under similar rationale.

With regards to claim 25, which depends on claim 21, for a player that performs a method similar to the method of claim 13, is rejected under similar rationale.

With regards to claim 26, which depends on claim 21, for a player that performs a method similar to the method of claim 18, is rejected under similar rationale.

With regards to claim 27, which depends on claim 21, for a player that performs a method similar to the method of claim 19, is rejected under similar rationale.

With regards to claim 28, for an information carrier that performs a method similar to the method of claim 11, is rejected under similar rationale.

With regards to claim 29, which depends on claim 28, for an information carrier that performs a method similar to the method of claim 15, is rejected under similar rationale.

With regards to claim 30, which depends claim 28, on an information carrier that performs a method similar to the method of claim 13, is rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freund (US Patent: 5,987,611, issued: Nov. 16, 1999, filed: May 6, 1997), in view of Morgan et al (US Application: 2005/0005165 A1, published: Jan. 6, 2005, filed: Jun. 25, 2003).

With regards to claim 20, which depends on claim 11, Freund teaches *wherein the information carrier*, as similarly explained in the rejection for claim 19, and 11, and is rejected under similar rationale.

However, Freund does not expressly teach the information carrier *is a DVD*.

Yet, Morgan et al teaches storing and retrieving information in an internet filtering system while using an information carrier such as a DVD (paragraph 0029, and 0075: whereas DVD is used as a form of storage medium).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Freund's method for storage/retrieval, such that the method would have further included storage/retrieval from a DVD, as taught by Morgan et al. The combination of Freund and Morgan et al would have allowed Freund to have implemented "an application programming interface [which is] provided for applications to inform a firewall of an application's need." (Morgan et al, paragraph 0009).

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freund (US Patent: 5,987,611, issued: Nov. 16, 1999, filed: May 6, 1997), in view of Casais (US Application: US 2003/0040341 A1, published: Feb. 27, 2003, filed: Sep. 10, 2002).

With regards to claim 22, which depends on claim 21, Freund teaches *the reader,* as similarly explained in the rejection for claim 21, and is rejected under similar rationale. However, Freund does not expressly teach *if* the reader *does not read the application information, the access device is configured to provide unencumbered Internet access*. Yet, Casais teaches *if* the reader *does not read the application information, the access device is configured to provide unencumbered Internet access* (paragraph 0031: whereas if the browser application does not read other application information, and just provides unencumbered Internet access. Otherwise, the browser reads voice application information which provides access based upon recognized speech utterances).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Freund's reader, such that the reader would also supply unencumbered internet access based upon the type of input, as taught by Casais. The combination would have allowed Freund to have implemented "a method for retrieving information to be displayed on mobile devices" (Casais, paragraph 0010).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CESAR B PAULA/
Primary Examiner, Art Unit 2178

/Wilson Tsui/
Examiner, Art Unit 2178
April 09, 2008